



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/085,966	02/28/2002	Gerald D. Eckstein	8266-0823	3797

7590 01/06/2006

Bose McKinney & Evans LLP
Intellectual Property Group
2700 First Indiana Plaza
135 North Pennsylvania Street
Indianapolis, IN 46204

EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
----------	--------------

3754

DATE MAILED: 01/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/085,966	Applicant(s) ECKSTEIN ET AL.	
	Examiner Eric Keasel	Art Unit 3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-24, 26 and 55-63 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-24, 26 and 55-63 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 May 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim History and Clarification of Claims of Record

1. Applicant filed the continuation application 10/085,966 including claims 1-20 on Feb 28, 2002 with a preliminary amendment filed the same date canceling claims 1-20 and adding new misnumbered claims 1-19. The Examiner restricted the case in an office action mailed August 19, 2002. In the restriction, the examiner renumbered new claims 1-19 as 21-39 per 37 CFR 1.126. Applicant replied to the restriction requirement on September 19, 2002. Applicant appeared to understand what was meant by renumbering the claims in accordance with 37 CFR 1.126 because applicant elected claims 21-27, cancelled claims 28-39 and added new claim 40 (applicant did not amend the dependencies because they appeared to understand that when the examiner renumbered the claims, this included renumbering the dependencies). The non-final rejection was mailed November 4, 2002 rejecting claims 21-27 and 40. Applicant replied December 18, 2002, amending the existing claims and adding new claims 41-54. In the final rejection, mailed March 6, 2003, claims 45-54 were withdrawn from consideration as directed to non-elected inventions and claims 21-27 and 40-44 were finally rejected. On April 28, 2003, applicant filed an after-final amendment, proposing amendments to independent claims 21 and 40 and canceling claims 41-54. In an Advisory Action, mailed May 6, 2003, the examiner indicated the amendment would not be entered. Applicant filed an RCE on May 16, 2003, and checked the box indicating that the previously submitted amendment should be entered. Thus, claims 41-54 were then cancelled and claims 21-27 and 40 were pending. On July 15, 2003, the non-final rejection was mailed rejecting claims 21-27 and 40 (these were the only pending claims

Art Unit: 3754

because claims 41-54 were cancelled). On August 28, 2003, applicant replied to the non-final rejection, amending the existing claims and presenting misnumbered new claims 41-49 even though applicant had previously cancelled claims 41-54. The final rejection, mailed October 21, 2003, renumbered the misnumbered new claims 41-49 to 55-63 per 37 CFR 1.126. The amendment to the claims rendered claims 21, 25, 27, and 40 drawn to non-elected inventions. So claims 22-24, 26, and 55-63 were finally rejected and claims 21, 25, 27, and 40 were withdrawn from consideration. Applicant filed a proposed after-final amendment on December 29, 2003. Applicant appeared to acknowledge that claims 41-49 had been renumbered 55-63 because they are referred to in the listing of the claims and the arguments as claims 55-63, but applicant appeared to think that the dependencies were not renumbered. It is unclear why applicant thought that the dependencies were not changed when the claims were renumbered because 1) there were no rejections or objections that claims 59-63 were dependent on cancelled claims and 2) applicant understood what was meant by renumbering the claims earlier in prosecution. Applicant then filed a petition on April 9, 2004 and included an Appendix A with a different amendment than the proposed amendment filed December 29, 2003 (apparently it was then thought the claims 41-49 were still of record). Nevertheless, a Decision on Petition is now in the record that requires the entry of the amendment filed December 29, 2003. So, it is the amendment of December 29, 2003 that is entered. The decision will also be constructively read as a waiver of 37 CFR 1.121 for purposes of entry of this amendment. The amendment of December 29, 2003 also changes recitations within claims 58 and 61-63. Since some of the rejections of record must be modified or reconsidered in light of these new limitations, the examiner will reopen prosecution.

2. In view of the Decision to enter the after-final amendment filed on December 29, 2003, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:



MICHAEL MAR
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700

Drawings

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the position of the lever being independent of the presence of the electrical input of the solenoid must be shown or the feature(s) canceled from the claim(s). No new matter should be entered. Although the drawings

show a limited, lost-motion connection between the armature of the solenoid and the lever, this does not show an independence between the position of the lever and the presence of the electrical input of the solenoid (in fact there would appear to be at least some dependence).

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Art Unit: 3754

5. Claims 22-24, 26, and 55-63 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

During prosecution, the negative limitation that the position of the lever was independent of the presence of the electrical input to the solenoid was added and is present in each of the independent claims. This limitation was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The disclosed invention describes a limited, lost-motion connection between the armature and the lever. However, this implies at least some dependence between the lever position and the presence of a current sent to the solenoid. Whether or not a current is sent to the solenoid determines the position of the armature, and the degree to which the lever moves given a certain manual force is dependent on whether or not this force has to also raise the weight of the armature or not. So, there is at least some dependence from the presence of the electric input on the solenoid to the position of the lever. This is a new matter rejection.

Claims 61-63 recite, “the lever is movable into a first lever position wherein the first and second biasing mechanisms are in equilibrium”. In the application as filed, the relative forces of the springs biasing the lever are never defined as being in equilibrium in any position. In fact, it would appear that the engagement of the bottom surface (234, 242) and the bar (216) along with

Art Unit: 3754

the forces applied to the lever and solenoid dictate the position of the lever. This is a new matter rejection.

6. In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 22, 55, and 56 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Rutherford et al. (US Patent Number 2,389,387).

Rutherford et al. disclose a valve assembly including a manifold block having an inlet, an outlet, and a conduit in fluid communication with the inlet and with the outlet, a valve (29, 28) having a portion movable within the conduit between a first position inhibiting fluid communication between the inlet and the outlet, and a second position permitting fluid communication between the inlet and the outlet; a lever (43) connected to the valve to permit manual movement of the valve between the first and the second positions; a solenoid (48, 57) connected to the valve to move the valve between the first and second positions in response to an electrical input to the solenoid, the position of the lever being independent of the presence of the electrical input to the solenoid (the reference meets the “independent” limitation at least to the same extent that applicant’s disclosure does); and a lock (44, 47) engaging the lever to lock the

Art Unit: 3754

lever in a position having the valve in the second position; wherein the lock is integral with the lever; and the lock is activated by pressure on the lever (i.e. retracting the pin against the spring force).

9. Claims 22, 55, and 56 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Larson (US Patent Number 2,828,102).

Larson discloses a valve assembly including a manifold block having an inlet, an outlet, and a conduit in fluid communication with the inlet and with the outlet, a valve (18, 25) having a portion movable within the conduit between a first position inhibiting fluid communication between the inlet and the outlet, and a second position permitting fluid communication between the inlet and the outlet; a lever (41) connected to the valve to permit manual movement of the valve between the first and the second positions; a solenoid (23, 24) connected to the valve to move the valve between the first and second positions in response to an electrical input to the solenoid, the position of the lever being independent of the presence of the electrical input to the solenoid (the reference meets the “independent” limitation at least to the same extent that applicant’s disclosure does); and a lock (41a) engaging the lever to lock the lever in a position having the valve in the second position; wherein the lock is integral with the lever; and the lock is activated by pressure on the lever (see Fig. 2 and the accompanying text).

10. Claims 26, 57, 58, and 61-63 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Pilolla (US Patent Number 5,358,213).

Pilolla discloses a valve assembly (10) with a manifold having an inlet (32), outlet (48), and a conduit (72) therebetween. A valve (110, 130) inhibits or permits flow between the inlet and outlet. A lever (182) is pivotally connected to the manifold (see ref. no. 189 and column 5,

Art Unit: 3754

lines 33-37) and located entirely outside the conduit. A solenoid (140) is positioned between the manifold (which is defined as the part of the housing structure that has the inlet, outlet, and conduit therebetween) and lever and directly connected to the valve. The position of the lever is independent of the presence of the electrical input to the solenoid. Fig. 1 shows the valve closed, Fig. 2 shows the valve opened by the manual lever, and Fig. 4 shows the valve opened by electrical actuation of the solenoid (note the lever does not move). Re claim 58, the broadly worded biasing mechanisms can be read as the user's hand lifting the lever and gravity working in the other direction (please note, the limitation must be read as being broader than "springs" for dependent claim 59 to further limit claim 58). Re claim 61-63, the lever is movable (i.e. capable of being moved) to a position in which the broadly recited bias mechanisms of claim 58 are in equilibrium, the lever (182) is biased downwardly by gravity and the force of a hand pushing down when the lever is in the up position, and it is urged up when the bias force of the hand moves the handle up against the force of gravity. "[F]or a hospital bed" and "configured to connect to a device for positioning the bed" are intended use recitations. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

12. Claims 22-24, 55, and 56 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Pilolla (US Patent Number 5,358,213) in view of McNabb (US Patent Number 5,487,493).

Pilolla discloses a valve assembly (10) with a manifold having an inlet (32), outlet (48), and a conduit (72) therebetween. A valve (110, 130) inhibits or permits flow between the inlet and outlet. A lever (182) is pivotally connected to the manifold (see ref. no. 189 and column 5, lines 33-37) and located entirely outside the conduit. A solenoid (140) is positioned between the manifold and lever and directly connected to the valve. The position of the lever is independent of the presence of the electrical input to the solenoid. Fig. 1 shows the valve closed, Fig. 2

Art Unit: 3754

shows the valve opened by the manual lever, and Fig. 4 shows the valve opened by electrical actuation of the solenoid (note the lever does not move).

Pilolla fails to disclose the lock engaging the lever (being a lock bar and a lock solenoid). McNabb discloses lock bar (29) and a lock solenoid (24) moving the lock bar to engage a lever (20) in a similar manual operated valve. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the lock bar and lock solenoid of McNabb in the valve assembly of Pilolla ('213) in the position where the lever is in the second, open position (see Fig. 2) in order to latch the lever to inhibit operation as taught by McNabb (see the first sentence of the abstract).

Re claim 55, "integral" must be read broadly as applicant's lock only is indirectly connected to the lever through other parts in the non-engaging setting. The modified Pilolla meets the interpretation of "integral" consistent with applicant's disclosure. Re claim 56, if "pressure" is read as "solenoid actuated" (i.e. applicant's definition), then the modified Pilolla meets the claim.

Response to Arguments

13. Applicant's arguments have been considered but are largely moot in view of the new ground(s) of rejection. Regarding the solenoid of Pilolla being positioned between the lever and the manifold, the examiner disagrees with applicant's assertion. See Fig. 1 of Pilolla. The lever is at the top, the solenoid is below that and the manifold is below that. The manifold is the part of the housing structure that has the inlet, outlet, and the conduit therebetween. Regarding the lever "including" first and second bias mechanisms, applicant has disclosed a device that has a

Art Unit: 3754

lever (210) and two distinct bias mechanisms (254, 256) that impart a bias force on the lever.

The weight of the lever and the user engaging the lever biasing the lever both up and down are biasing mechanisms that meet this limitation. If applicant insists on maintaining that their lever “includes” bias mechanisms, rather than have bias mechanisms that impart a force on the lever, then the drawings will be further objected to for not showing the claimed invention because the disclosed lever and springs are separate elements and the lever does not “include” these separate elements as applicant is arguing. Regarding an explicit teaching of the motivation to combine the latch (lock) of McNabb to Pilolla, the reference gives explicit motivation in the name of the element (i.e. the motivation to add a latch is to latch, see the first sentence of the abstract).

Conclusion

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (571) 272-4929. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Michael Mar can be reached on (571) 272-4906. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3754

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Eric Keasel". The signature is fluid and cursive, with the first name "Eric" and last name "Keasel" clearly distinguishable.

Eric Keasel
Primary Examiner
Art Unit 3754